

REMARKS

Claims 2-11, 13-19, and 22 are pending in the present application.

This Amendment is in response to the Final Office Action mailed September 11, 2008. In the Final Office Action, the Examiner rejected claims 2-11, 13, 14-19, and 22 under 35 U.S.C. §103(a). Reconsideration in light of the remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. § 103

In the Final Office Action, the Examiner rejected claims 2-11, 14-19, and 22 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,173,400 issued to Perlman et al. ("Perlman") in view of Hugo Krawczyk "New Hash Functions for Message Authentitcation", 1988 ("Krawczyk"); and claim 13 under 35 U.S.C. §103(a) as being unpatentable over Perlman and Krawczyk as applied to claims 2-11, 14-19, and 22 above, and futher in view of U.S. Patent No. 5,703,952 issued to Taylor ("Taylor"). Applicant respectfully traverses the rejection and submits that the Examiner has not met the burden of establishing a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* §2143, p. 2100-126 to 2100-130 (8th Ed., Rev. 5, August 2006). Applicant respectfully submits that there is no suggestion or motivation to combine their teachings, and thus no *prima facie* case of obviousness has been established.

Perlman, Krawczyk, and Taylor, taken alone or in any combination, do not disclose or render obvious, at least, one of: (1) generating an integrity check value by the first device, comprising: (1a) extracting a selected number of bits from a pseudo-random data stream for use as coefficients of a matrix having M rows and N columns, and (1b) performing operations on both contents of the message and the coefficients of the matrix to generate the integrity check value, as recited in independent claim 2.

The Examiner argues that Perlman shows generating “an integrity check value by the first device,” citing to column 4, lines 42-64. Applicant respectfully disagree and submits that Perlman merely discloses a shared secret being established using an authentication token that generates a character string which is a password based on the time of day encrypted with a secret code or a random number (Perlman, col. 4, lines 43-48), not an integrity check value, as recited in the claim. In Perlman, the character string is communicated to a local device (e.g., workstation). (Perlman, col. 4, lines 48-52). In contrast, as delineated in the claim, the integrity check value is generated by “extracting a selected number of bits from a pseudo-random data stream for use as coefficients of a matrix having M rows and N columns, and performing operations on both contents of the message and the coefficients of the matrix.” Since the character string is based on the time of day encrypted with a secret code rather than being generated by performing operations on the message and the coefficients of the matrix, the character string cannot be the integrity check value.

In the Response to Argument section of the Final Office Action, the Examiner further contends that “the remote device (first device) and the user’s local device (second device) are mutually authenticated, once the communication is secured, an integrity check value is performed which may be used to encrypt data” (Final Office Action, page 2). Applicant respectfully disagrees and submits that there is no support in Perlman that “an integrity check value is performed” as alleged by the Examiner. In fact, Perlman merely states:

“The remote device and the user’s local device can then share the matching value or a function of the matching value as a secret to encrypt and enhance the integrity of information transferred therebetween and/or perform mutual authentication” (Perlman, col. 4, lines 56-60).

Accordingly, Perlman merely discloses using the shared secret to enhance integrity of information. Enhancing information integrity does not imply that an integrity check value is generated. Moreover, as discussed above the shared secret generates a character string which cannot be the integrity check value as delineated in claim 2.

In addition, the Examiner argues that Krawczyk shows “extracting bits randomly for use as coefficients of a matrix having M rows and N columns and performing operations to generate the integrity check value,” citing to pages 301-303 (Final Office Action, page 5). Applicant respectfully disagrees. Krawczyk merely discloses Toeplitz matrices being characterized by

having fixed diagonals (Krawczyk, page 303, Section 2.1), and the Toeplitz matrices of dimension $n \times m$ being used to hash messages of length m by multiplying the message by the matrix (Krawczyk, page 303, Section 2.1). In contrast, the claim 2 recites “*performing operations on both contents of the message and the coefficients of the matrix to generate the integrity check value*”. Since hashing messages is not the same as *generating the integrity check value*, Krawczyk, in discussing Toeplitz matrices, does not teach or suggest this element of the claim. Furthermore, Krawczyk does not teach or suggest performing operations on both the contents of the message and the coefficients of the matrix to generate the integrity check value, as recited in claim 2.

In the Response to Argument section of the Final Office Action, the Examiner contends that “the Toeplitz matrices perform operations on both the contents of the hash message as well as the coefficients which are the random bits used to generate a sequence” (Final Office Action, pages 2-3). Applicant respectfully disagrees and submits that Krawczyk merely states:

“To any given sequence s of $n + m - 1$ bits we associate an $n \times m$ Toeplitz matrix T_s , where the elements of s determines the first column and first row of T_s , and therefore, the whole matrix. ... Toeplitz matrices of dimension $n \times m$ can be used to hash messages of length m by multiplying the message by the matrix. The resultant hash value has length n ” (Krawczyk, page 303).

Accordingly, in Krawczyk, the sequence s is used to create the Toeplitz matrix which is used to hash messages of length m . Since the hashing merely requires “multiplying the message by the matrix”, there is no teaching or suggestion of operations being performed on both the contents of the message and the coefficients of the matrix, as delineated in the claim.

Moreover, even assuming that the Toeplitz matrices performing operations on both the contents of the hash message as well as the coefficients were to correspond to *performing operations on both contents of the message and the coefficients of the matrix*, there is still no teaching or suggestion that the Toeplitz matrices performing operations on both the contents of the hash message as well as the coefficients is to generate the integrity check value, as delineated in the claim. As discussed above, Krawczyk merely discloses hashing messages which is not the same as generating the integrity check value. Thus, neither Krawczyk or Perlman discloses this element of the claims.

Moreover, Applicant respectfully submits that the Examiner impermissibly uses hindsight reconstruction. While Applicant discloses in the Specification that in one embodiment of the

invention “a Toeplitz matrix 700 in lieu of integrity matrix 600” is used (See Specification, page 12 for further details), there is no teaching or suggestion in Krawczyk of performing operations on the coefficients of the Toeplitz matrix to generate the integrity check value since Krawczyk merely discloses using the Toeplitz matrix to hash messages.

With respect to the independent claim 18, as discussed above, Perlman in view of Krawczyk fails to teach or suggest at least one of: generating an integrity check value, producing the integrity check value based on a selected group of bits from a pseudo-random data stream and contents of the message.

In the Response to Argument section of the Final Office Action, the Examiner asserts that one cannot show nonobviousness by attacking references individually where the rejections are based on a combination of references (Final Office Action, page 3). Applicant respectfully submits that the arguments as set forth above demonstrates that the combination of Perlman and Krawczyk fails to disclose the elements of “generating an integrity check value,” and “producing the integrity check value based on a selected group of bits from a pseudo-random data stream and contents of the message,” as recited in claim 18.

More specifically, as discussed above, in Perlman, the shared secret generates a character string which cannot be the integrity check value. Moreover, Krawczyk merely discloses hashing messages which is not the same as generating the integrity check value. Accordingly, the combination of Perlman and Krawczyk does not disclose “generating the integrity check value” and “producing the integrity check value based on a selected group of bits from a pseudo-random data stream and contents of the message”.

With respect to claim 13, Applicant agrees with the Examiner that neither Perlman nor Krawczyk explicitly disclose the feature of decrypt an incoming message, computing an integrity check value for an incoming message and determining whether the incoming message is valid by comparing the computed integrity check value with the recovered integrity check value, as recited in the claim (Final Office Action, page 11). However, Applicant respectfully disagrees that Taylor teaches the elements of claim 13.

Please note that in the Response to Argument section of the Final Office Action, the Examiner disagrees that neither Perlman nor Krawczyk explicitly disclose these elements of claim 13 and alleges that Applicant cannot show nonobviousness by attacking references

individually where the rejections are based on combinations of reference (Final Office Action, page 3). Applicant respectfully submits that the Examiner explicitly states that on page 11 of the Final Office Action that neither Perlman nor Krawczyk explicitly disclose the feature of decrypt an incoming message, computing an integrity check value for an incoming message and determining whether the incoming message is valid by comparing the computed integrity check value with the recovered integrity check value, as recited in claim 13 (Final Office Action, page 11) and Applicant is merely agreeing with the Examiner's statement on page 11 regarding deficiencies of Perlman and Krawczyk.

Moreover, Applicant respectfully disagrees that Taylor teaches the elements of claim 13. Taylor allegedly discloses an integrity function being applied to result in an integrity check value which is forwarded to the encryption processor 26 (Taylor, col. 11, lines 5-7), but irregardless of such alleged teachings, Taylor does not disclose *determining whether the incoming message is valid by comparing the computed integrity check value with a recovered integrity check value*, as recited in claim 13. At the encryption processor 26, the integrity check value is appended as a message authentication code onto the end of the plain text message (Taylor, col. 11, lines 7-11). Thus, a single integrity check value is computed and subsequently appended to plain text message. Since Taylor merely discloses a single integrity check value, there is no teaching or suggestion of comparing the computed integrity check value with a recovered integrity check value.

In addition, the Examiner alleges that Taylor teaches the elements by citing to the language in column 16, lines 66-67 and in column 17, lines 1-2, which are claims 25 and 26 (Final Office Action, page 12). Applicants respectfully submit that it is impermissible to rely on the language in the claims as support for the teachings of Taylor. The scope of a patent's claims determines what infringes a patent; it is no measure of what it discloses. In re Benno, 768 F2d 1340, 226 USPQ 683, 686 (Fed.Cir.1985). Thus, the rejection based on claim language within Taylor is impermissible.

In the Response to the Argument section of the Final Office Action, the Examiner states "the Examiner clearly points out that Taylor discloses... determining whether the incoming message is valid by comparing the computed integrity check value with the recovered integrity

check value (See column 11, lines 7-14 and column 16, lines 66-67)” (Final Office Action, page 4). Applicant respectfully submits that:

Where a claim is refused for any reason relating to the merits thereof it should be “rejected” and the ground of rejection fully and clearly stated. See MPEP 707.07(d). Where the applicant traverses an objection, the Examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it. See MPEP 707.07(f). It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. See MPEP 706.02(j). The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of a patentability and otherwise reply completely at the earliest opportunity. See MPEP 706.

Here, the Examiner repeated the rejection without taking note of the Applicant’s arguments and without answering the substance of Applicant’s arguments as presented in the response filed on June 16, 2008 and repeated herein. The MPEP requires that the Examiner’s action will be complete as to all matters. 37 CFR §1.104; MPEP §707.07. Since the Examiner’s action in the Final Office Action is incomplete in that there is no answer to the substance of Applicant’s arguments previously presented, the rejections have been improperly made.

When applying 35 U.S.C. §103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) Reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). To defeat patentability based on obviousness, the suggestion to make the new product having the claimed characteristics must come from the prior art, not from the hindsight knowledge of the invention. *Interconnect Planning Corp. v. Feil*, 744 F.2d 1132, 1143, 227 USPQ (BNA) 543, 551 (Fed. Cir. 1985). “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973. (Bd.Pat.App.&Inter. 1985). The mere fact that references can be combined or

modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Moreover, the Examiner failed to establish the factual inquires in the three-pronged test as required by the *Graham* factual inquires. There are significant differences between the cited references and the claimed invention as discussed above. Furthermore, the Examiner has not made an explicit analysis on the apparent reason to combine the known elements in the fashion in the claimed invention. Accordingly, there is no apparent reason to combine the teachings of Perlman, Krawczyk, and Taylor in any combination.

Therefore, Applicant believes that independent claims 2, 13, and 18 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicant respectfully requests the rejection under 35 U.S.C. §103(a) be withdrawn.

Conclusion

Applicant reserves all rights with respect to the applicability of the doctrine of equivalents. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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Dated: January 11, 2009

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